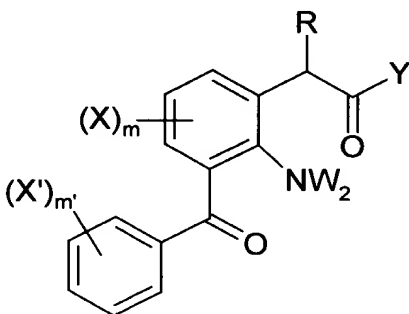


## I. AMENDMENT

Please make the following amendments:

### In the Claims

1. (amended) A method of treating or preventing an angiogenesis-related disorder in a patient suffering from such a disorder which comprises administering to the patient a therapeutically effective amount of 3-benzoylphenylacetic acid or derivative of the formula:



wherein

R = H, C<sub>1-4</sub> (un)branched alkyl, CF<sub>3</sub>, SR<sup>4</sup>;

Y = OR', NR''R';

R' = H, C<sub>1-10</sub> (un)branched alkyl, (un)substituted (substitution as defined by X below), (un)substituted heterocycle (substitution as defined by X below),

-(CH<sub>2</sub>)<sub>n</sub>Z(CH<sub>2</sub>)<sub>n'</sub>A;

n = 2-6;

n' = 1-6;

Z = nothing, O, C=O, OC(=O), C(=O)O, C(=O)NR<sup>3</sup>, NR<sup>3</sup>C(=O), S(O)<sub>n2</sub>, CHOR<sup>3</sup>, NR<sup>3</sup>;

n<sup>2</sup> = 0-2;

R<sup>3</sup> = H, C<sub>1-6</sub> (un)branched alkyl, (un)substituted aryl (substitution as defined by X below),

(un)substituted heterocycle (substitution as defined by X below);

A = H, OH, optionally (un)substituted aryl (substitution as defined by X below), (un)substituted heterocycle (substitution as defined by X below), -(CH<sub>2</sub>)<sub>n</sub>OR<sup>3</sup>;

R'' = H, OH, OR';

X and X' independently = H, F, Cl, Br, I, OR', CN, OH, S(O)<sub>n2</sub>R<sup>4</sup>, CF<sub>3</sub>, R<sup>4</sup>, NO<sub>2</sub>;

R<sup>4</sup> = C<sub>1-6</sub> (un)branched alkyl;

m = 0-3;

m' = 0-5; and

W = O, H.

## **II. RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Claims 1-9 were originally filed with the case and were pending at the time of the present Action. Claim 1 is amended herein to clarify the subject matter of the claims. No claims are added or cancelled herein. Thus, claims 1-9 remain pending. As required in 37 C.F.R. § 1.121(c)(1)(ii), a marked up version of the amended claims is attached hereto as Appendix A. For the Examiner's convenience, a clean copy of all pending claims is attached hereto as Appendix B.

### **B. The Claims Are Patentable Over Yanni and Shanklin**

The Action rejects all claims as anticipated by or, in the alternative, as obvious over U.S. Patent No. 5,475,034 (Yanni *et al.*) and U.S. Patent No. 4,313,949 (Shanklin *et al.*). The patents are said to teach the administration of the compounds of the invention to a patient. It is acknowledged that the cited references lack a teaching of angiogenesis-related disorders. Nevertheless, the Action takes the position that the skilled artisan would "find ample motivation" from the cited art to administer the known compounds to a patient "predisposed to such a disorder." Applicants respectfully traverse.

The present invention is directed to the use of certain 3-benzoylpehnylacetic acids and derivatives to treat or prevent angiogenesis-related disorders. The compounds of the present invention are useful for the treatment or prevention of angiogenesis-related disorders. Such disorders include those that involve the proliferation of tumor cells, such as prostate cancer, lung cancer, breast cancer, bladder cancer, renal cancer, colon cancer, gastric cancer, pancreatic cancer, ovarian cancer, melanoma, hepatoma, sarcoma and lymphoma. Ophthalmic angiogenesis-related disorders include, but are not limited to exudative macular degeneration, proliferative diabetic retinopathy, ischemic retinopathy (e.g., retinal vein or artery occlusion), retinopathy of prematurity, neovascular glaucoma, iritis rubeosis, corneal neovascularization, cyclitis, sickle cell retinopathy, and pterygium.

For a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show *all* features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984).

Neither Yanni nor Shanklin contains any teaching whatsoever of the treatment of angiogenesis-related diseases. Clearly, since Yanni and Shanklin both fail to teach at least one element of the claimed invention, they do not meet the requirements of anticipation.

With respect to obviousness, it is well settled patent law that "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); MPEP § 2143. The Federal Circuit stated in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), that there are three possible sources to find a motivation to combine or modify references: 1) the nature of the problem to be solved; 2) the teachings of the prior art; and 3) the knowledge of one of skill in the art. *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457-58.

The Action acknowledges that neither reference teaches the use of the compounds of the invention to treat angiogenesis-related disorders. Furthermore, the Action appears to acknowledge that neither the references, nor their combination, teaches a method of treating angiogenesis-related disorders in a patient suffering from such a disorder. Rather, the Action takes the position any patient would qualify as a "patient . . . predisposed to [an angiogenesis-related] disorder" and therefore takes the position that the invention would be obvious to the skilled artisan. After a close inspection of the

cited references, Applicants can find no teaching or suggestion of the treatment of patients predisposed to an angiogenesis-related disorder with the compounds of the invention.

It is submitted that the Action bases its rejection upon the Applicants' disclosure in the present specification. This amounts to an improper "hindsight reconstruction" of the invention based upon the teaching in the present application. *See In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In *Fine*, the court explained that

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

*Fine*, 5 U.S.P.Q.2d at 1600 (quoting *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

The rejection under § 103 based on the combination of Shanklin and Yanni amounts to a "picking and choosing" of certain parts of the references while ignoring other aspects of it. The Federal Circuit has held that "it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference *fairly suggests* to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986) (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA 1965)). What the Action ignores is the fact that nowhere within Shanklin or Yanni is a method for the treatment of patients suffering from, or predisposed to, angiogenesis-related diseases. The Action provides no support for the assertion that any patient would be "predisposed to such a disorder."

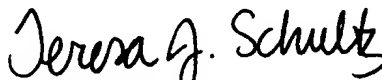
Nevertheless, without acquiescing in the rejection and solely to advance the case to allowance, Applicants amend the claims herein to delete the recital of the phrase "predisposed to such a disorder." In light of the foregoing arguments, Applicants respectfully request that the anticipation/obviousness rejection based on Shanklin and Yanni be withdrawn.

C. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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